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Notice of Allowability	Application No.	Applicant(s)	
	09/800,572	MIZUKAWA ET AL	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 8/12/03.
2. ☒ The allowed claim(s) is/are 1-18.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), <u>Paper No. 8/12/03</u> | 6 <input type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

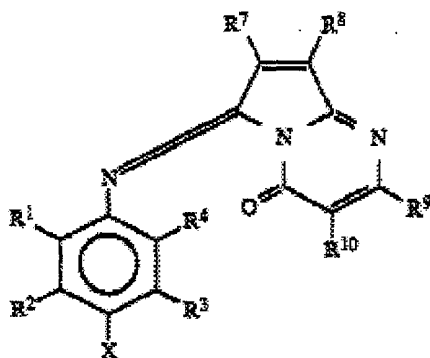
Statement of Reasons for Allowance

1. In the office action mailed 3/12/03, the only rejections of record against the present claims were those made under 35 USC 112, 1st and 2nd paragraphs.

Applicants' amendment filed 8/12/03 which amends claims 1, 10, and 12 to recite specific substituents for R₁-R₆ and R₉-R₁₃ overcomes the 35 USC 112, 1st paragraph rejection of record while the amendment to claims 15 and 16 to change the claim dependencies overcomes the 35 USC 112, 2nd paragraph rejection of record.

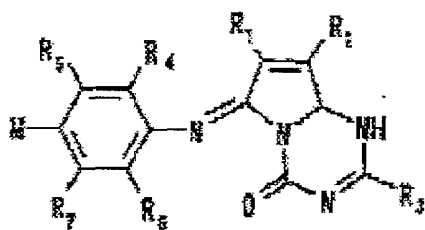
As stated in the office action mailed 3/12/03, and restated below, the present claims are allowable over the "closest" prior art Mikoshiba et al. (U.S. 5,344,933), JP 2000-327939, Tsutsumi et al. (U.S. 6,031,019), and JP 08269374 for the following reasons:

Mikoshiba et al. disclose ink jet ink comprising oil-soluble dye of the formula:



which falls outside the scope of the dyes set forth in the present claims.

JP 2000-327939 disclose ink jet ink comprising oil-soluble dye of the formula:



which is identical to the presently claimed dye. However, the filing date of JP 2000-327939 lies between the filing date and the priority date of the present application as seen below:

Application No. 09/800,572 *priority date* – 3/27/00

JP 2000-327939 *filing date* – 11/28/00

Application No. 09/800,572 *filing date* – 3/8/01

Under MPEP 706.02(b), rejections based on 35 U.S.C. 102(a) can be overcome by perfecting the filing date of the priority document. Applicant's submission of certified priority document on 3/8/01 and its certified English language translation on 12/18/02 results in the perfection of the foreign priority filing date. Thus, JP 2000-327939 is no longer applicable against the present claims.

Tsutsumi et al. (U.S. 6,031,019) disclose ink jet ink comprising coloring particulates comprising oil-soluble dye and oil-soluble polymer. However, there is no disclosure or suggestion of oil-soluble dye as required in all the present claims.

JP 08269374 discloses ink jet ink comprising water, high boiling solvent, oil-soluble dye, and oil-soluble polymer, however, there is no disclosure or suggestion of oil-soluble dye as required in all the present claims.

In light of the above, it is clear that Mikoshiba et al., Tsutsumi et al., and JP 08269374, either alone or in combination do not disclose or suggest the present invention.

Applicants' IDS filed 8/12/03 has been considered. The present claims are allowable over the cited prior art Yao (U.S. 4,246,154), Lepesant et al. (U.S. 4,409,039), Ohta et al. (U.S. 4,597,794), Anton et al. (U.S. 6,020,400), Yamakawa et al. (U.S. 6,383,276), JP 01170674, JP 04039365, JP 03103484, JP 08183920, JP 08286340, JP 10279873, JP 62207375, JP 2000-303009, and US 2001/0045176 given that none of the references discloses or suggests oil-soluble dye as required in all the present claims. Further, given the effective filing dates of US 2001/0045176, US 2002/0007762, US 2002/0067399, and US 2002/0112641, these references are not applicable against the present claims under any subsection of 35 USC 102.

In light of the above, the present claims are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

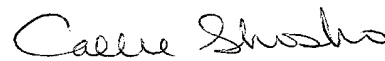
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

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9/22/03